



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,095	05/03/2001	Jay M. Short	DIVER1280-10	7088

7590

06/30/2003

Lisa A. Haile, Ph.D.  
GRAY CARY WARE & FREIDENRICH LLP  
Suite 1100  
4365 Executive Drive  
San Diego, CA 92121-2189

EXAMINER

KETTER, JAMES S

ART UNIT	PAPER NUMBER
----------	--------------

1636

21

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
**U.S. Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER
----------

ART UNIT	PAPER
----------	-------

21

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

--See attached--

# Office Action Summary

Application No.

09/848,095

Applicant(s)

SHORT ET AL.

Examiner

James S. Ketter

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-18,20-28,33-44 and 47-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-18,22-28,33-44 and 50-55 is/are rejected.
- 7) ☒ Claim(s) 20, 21 and 47-49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

In response to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures, attached to paper no. 13, mailed 19 November 2002, Applicants have requested, in Paper No. 16 filed 25 April 2003, that the CRF, sequence amendment and statement that the two are the same, be transferred from the parent application. As noted in the Advisory Action mailed 9 May 2003, however, only the CRF may be thus transferred. Applicants response of 25 April 2003 appears bona fide, and as such, the time period of the instant Office Action is set as the time period for response. See the new Notice to Comply, attached. Any response to this Office Action which fails to comply with all the remaining requirements under the sequence rules, 37 CFR §§ 1.821-1.825, those requirements being the need for a sequence amendment and a letter stating that the contents of the CRF and the sequence amendment are the same, will be held non-responsive.

Claims 20, 21 and 47-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 7-10, 16-18, 23-28, 33-36, 39-44 and 51-53 stand rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al. (US Patent 5,824,485) for reasons of

Art Unit: 1636

record set forth in Papers Nos. 5, 13 and 17, mailed 20 February 2002, 19 November 2002 and 9 May 2003, respectively.

Applicants' arguments in the amendment after final filed 25 April 2003 were addressed in the advisory action mailed 9 May 2003. Applicants have amended some of the claims in the amendment filed 22 May 2003, but have offered no further arguments.

It is noted that claim 1, as now amended, has another step, now designated "b)", drawn to the step of transferring a plurality of the clones to a myceliate bacteria or fungi. However, it is noted that Thompson et al. teaches the use of 2 Streptomyces species, Neurospora crassa or Aspergillus nidulans as host cells for the clones, e.g., at column 18, lines 45-59. As such, the instant claims remain anticipated by Thompson et al.

Claims 1, 2, 7-18, 23-28, 33-44 and 51-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. ('485) in view of Plovins et al. and Zhang et al. for reasons of record set forth in Papers Nos. 5, 13 and 17, mailed 20 February 2002, 19 November 2002 and 9 May 2003, respectively.

Applicants' arguments in the amendment after final filed 25 April 2003 were addressed in the advisory action mailed 9 May 2003. Applicants have amended some of the claims in the amendment filed 22 May 2003, but have offered no further arguments.

It is noted that claim 1, as now amended, has another step, now designated "b)", drawn to the step of transferring a plurality of the clones to a myceliate bacteria or fungi. However, it is noted that Thompson et al. teaches the use of 2 Streptomyces species, Neurospora crassa or

Art Unit: 1636

Aspergillus nidulans as host cells for the clones, e.g., at column 18, lines 45-59. As such, the instant claims remain rejected over the grounds set forth above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 7-18, 22-28, 33-44 and 50-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 26, and therefore all claims dependent therefrom, have been amended to recite the phrase "a myceliate bacteria or fungi". However, it is not clear whether the term "myceliate" is meant to limit "fungi". As such the metes and bounds of the instant claims are unclear.

Furthermore, while not part of the rejection, it is noted that the article "a", which is singular, refers to "bacteria" or "fungi", which are plural. Applicants may wish to bring the number into grammatical agreement.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1636

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Certain papers related to this application may be submitted directly to the Examiner by facsimile transmission at (703) 746-5155. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993)(see 37 CFR ' 1.6(d)). To send the facsimile to the Art Unit instead, the Art Unit 1636 Fax number is (703) 305-7939. NOTE: If Applicant does submit a paper by fax to this number, the Examiner must be notified promptly, to ensure matching of the faxed paper to the application file, and the original signed copy should be retained by Applicant or Applicant's representative. (703) 308-4242 or (703) 305-3014 may be used without notification of the Examiner, with such faxed papers being handled in the manner of mailed responses. Applicant is encouraged to use the latter two fax numbers unless immediate action by the Examiner is required, e.g., during discussions of claim language for allowable subject matter. NO

Art Unit: 1636


DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the Examiner with respect to the examination on the merits should be directed to James Ketter whose telephone number is (703) 308-1169. The Examiner normally can be reached on M-F (9:00-6:30), with alternate Fridays off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Remy Yucel, can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Jsk  
June 25, 2003



JAMES KETTER  
PRIMARY EXAMINER